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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/882,499	06/25/97	HUANG	R 41060

HM22/0928
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EXAMINER	
MARX, I	
ART UNIT	PAPER NUMBER
1651	20

DATE MAILED: 09/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/882,499

Applicant(s)

Huang et al.

Examiner

Irene Marx

Group Art Unit
1651



☒ Responsive to communication(s) filed on Aug 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 5-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 5-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 19

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Since this application is eligible as a Continued Prosecution Application under 37 CFR 1.153(d), the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.153(b). Applicant's submission after final filed on 2/8/00 has been entered.

Claims 5-7 are being considered on the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,663,209. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to a method of suppressing viral growth with substantially the same compounds as are used in the present invention.

Therefore, the claims are co-extensive.

The terminal disclaimer is acknowledged and it will be considered in due course.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is confusing in that the terminology "pharmaceutically acceptable **derivatives**". It is unclear what is intended by "derivatives" in this context, even when reading the claims in light of the specification. If chemical derivatives are intended, the nature thereof is not delineated with sufficient specificity in the as filed disclosure.

Claims 5-7 are/remain rejected under 35 U.S.C. 102(e) as being by clearly anticipated by Sinnott *et al.*. See, e.g. Example 3, wherein Sinnott *et al.* teaches the administration of a complex formulation comprising *Larrea tridentata* extracts. That *Larrea tridentata* comprises a variety of lignans having biological activity against viruses, including in particular also 3-O-methyl norhydroguaiaretic acid (Mal 4), is disclosed at col.2, lines 20-27. These compounds are inherently water soluble.

Applicants' arguments and declaration under 37 C.F.R. §1.131 have been fully considered but they are not deemed to be persuasive.

The declaration filed on 8/24/00 under 37 CFR 1.131 has been considered but is ineffective to overcome the Sinnott *et al.* reference.

The Sinnott *et al.* reference is a U.S. patent that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the patent is claiming the same patentable invention, see MPEP § 2306. The patent can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings.

Claims 7 and 8 of Sinnott *et al.* are directed to the administration of a composition comprising *Larrea tridentata* extracts for the treatment of viruses. That *Larrea tridentata* comprises a variety of lignans having biological activity against viruses, including in particular also 3-O-methyl norhydroguaiaretic acid (Mal 4), is disclosed at col.2, lines 20-27.

Therefore the rejection is deemed proper and it is adhered to.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Irene Marx
Primary Examiner
Art Unit 1651